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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,063	10/17/2001	Kazuhisa Kashiwazaki	0234-0433P	4184

2292 7590 10/18/2004

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EXAMINER
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MORILLO, JANELLE COMBS

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action****Application No.**

09/978,063

**Applicant(s)**

KASHIWAZAKI ET AL.

**Examiner**

Janelle Combs-Morillo

**Art Unit**

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 112 1<sup>st</sup> paragraph.
4. ☒ Newly proposed or amended claim(s) 17-20 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 14, 17-20.

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 3 and 9.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: the 1.132 declaration filed September 20, 2004 was insufficient to overcome the rejections of claims 3 and 9. Concerning product by process claim 3, applicant has not shown that the prior art alloy taught by JP'232 is materially different than the presently claimed product by process. That is, applicant has not shown that the alloy taught by JP'232 has materially different properties or structure than the presently claimed alloy product. Alternatively, as stated below, JP'232 and JP'054 are properly combinable, and said references teach Al-Si alloys processed substantially as presently claimed (see final rejection for details), and that have been reduced by >90% followed by >50% (see discussion below), which overlaps the presently claimed %reduction.

Concerning process claim 9, as stated in the final rejection, the alloy taught by JP'232 is clearly capable of being processed by either conventional DC ingot casting or direct casting rolling. In response to applicant's argument that one of skill in the art would not be motivated to combine JP'054 and JP'232, who are drawn to different casting methods for substantially similar Al-Si alloys, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Even if the two processes are substantially different (and associated with different microstructures due to solidification rates, etc), because the references suggest that Al-Si alloys that are substantially identical to the instant alloy can be processed by EITHER a) direct casting rolling or b) DC casting method, it would have been obvious to one of ordinary skill in the art to DC cast the Al-Si alloy taught by JP'232.

Concerning the argument that JP'054 does not teach or suggest the presently claimed rolling reduction, the examiner points out that JP'054 teaches a hot rolling reduction of >90% followed by a cold rolling reduction of >50% (page 2 column 1). Moreover, the examiner points out that if 300mm is a typical as cast ingot thickness for DC casting (as stated in Fig. A of the 1.132 Declaration), then a final thickness of 0.15mm as taught by JP'054 would imply a reduction of 99.95%. The declaration filed September 20, 2004 was insufficient to show unexpected results concerning %reduction (see Table III, etc.), because 90% reduction is not representative of the closest prior art of JP'054 (see above, as well as applicant's arguments p 13). Applicant submits that the instant invention is allowable because JP'054 teaches a %reduction of 95%, which is outside the claimed range of 98% or more (arguments p 13). However, applicant has not shown unexpected results with regard to the 95% reduction taught by JP'054, nor has applicant shown the criticality of the presently claimed range, with regard to the overlapping range taught by JP'054 (of >90% reduction followed by >50% reduction).

  
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